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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,899	05/22/1999	DARKO KIROVSKI	MSI-356US	8452

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,899

Applicant(s)

KIROVSKI ET AL.

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,5-16,24,27-32,35,36,40,41 and 43 is/are allowed.
- 6) ☒ Claim(s) 1,4,17,21-23,26,33,34,37-39 and 42 is/are rejected.
- 7) ☒ Claim(s) 18-20 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 17 October 2002 that amended claims 1, 12-15, 17-20, 22, 24, 25, 33, 36, 37, 40, and 41.

Response to Arguments

2. Applicant's arguments filed 17 October 2002 have been fully considered but they are not persuasive. Applicant traverses the examiner's taking of official notice but provides no reasoning behind the request for a reference. Furthermore, applicant does not even allege that the facts of which the examiner has taken official notice are incorrect. As such, no references need be provided.

3. Applicant's arguments with respect to claims 1, 4, 17, 21-23, and 33 have been considered but are moot in view of the new ground(s) of rejection.

4. With respect to claims 26, 34, and 37: in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., preclusion of both strong and weak watermarks existing in a portion of the audio signal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 4, 17, 21-23, 26, 33, 34, and 37 rejected under 35 U.S.C. 102(e) as being anticipated by Bloom et al. (6332194).

In lines 41-54 of column 1, Bloom et al. describe a “copy once” protection scheme that uses two watermarks, one fragile and one robust. This anticipates a pattern generator for the both the strong and weak watermarks. In an example stretching from line 10 of column 7 to line 14 of column 9, Bloom et al. show that the different watermarks are placed in different portions (lines 37-40 of column 7).

In use, a watermark detector determines if multiple watermarks are present; if there are two and they are not both strong watermarks, then the watermarked data can be copied. If there is only one watermark, then it is necessarily robust, and as such has been detected as being robust. See also the other paragraphs in the background section. As such, claim 17 is met. 4 and 21 are operating systems for 1 and 17. Claim

22 combines elements from claims 1 and 17. Claim 23 is anticipated by the distribution environment described by Bloom et al. (see, for example, line 18 of column 7).

7. Claims 26, 34, and 37 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Mintzer et al. ("If One Watermark is Good, Are More Better?").

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 38-39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mintzer et al. in view of Levine et al. (6209094).

Mintzer et al. show data that is watermarked with both robust, or strong, and fragile, or weak, watermarks. They do not say that the placement of any of these watermarks is determined by an audible measure of the data. In lines 45-51 of column 5, Levine et al. say that robust watermarks should be encoded into audible sections of a signal. If recorded into inaudible sections, the data with the robust watermarks could be removed without significantly perceptibly changing the signal. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the robust watermarks of Mintzer et al. within audible regions of the data so as to prevent the watermarks from being stripped without degrading the audio signal.

10. Claims 38, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom et al. in view of Levine et al. (6209094).

Bloom et al. teach inserting both robust and fragile watermarks into a signal. They do not say that the placement of any of these watermarks is determined by an audible measure of the data. In lines 45-51 of column 5, Levine et al. say that robust watermarks should be encoded into audible sections of a signal. If recorded into inaudible sections, the data with the robust watermarks could be removed without significantly perceptibly changing the signal. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the robust watermarks of Bloom et al. within audible regions of the data so as to prevent the watermarks from being stripped without degrading the audio signal.

Allowable Subject Matter

11. Claims 2, 3, 5-16, 24, 27-32, 35, 36, 40, 41, and 43 are allowed.
12. Claims 18-20 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kadono (6334187).
14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Douglas J. Meislahn
Examiner
Art Unit 2132

DJM
December 18, 2002

Matthew A. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2134